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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92061144
Party	Plaintiff 451 Marketing, LLC
Correspondence Address	SCOTT I WOLF SCHOLSSBERG LLC 35 BRAINTREE HILL OFFICE PARK SUITE 204 BRAINTREE, MA 02184 UNITED STATES swolf@sabusinesslaw.com, bdobush@sabusinesslaw.com
Submission	Other Motions/Papers
Filer's Name	Scott I. Wolf
Filer's e-mail	swolf@sabusinesslaw.com, ghillier@sabusinesslaw.com
Signature	/Scott I. Wolf/
Date	11/05/2015
Attachments	Consent.Agr.pdf(196830 bytes)

CO-EXISTENCE AND CONSENT AGREEMENT

This Co-existence and Consent Agreement ("Agreement") is made by and between **451 Marketing, LLC**, a Massachusetts limited liability company, with an address at 100 N. Washington Street, Boston, MA 02114 ("451M") and **Spark451 Inc.**, a New York corporation with an address at 865 Merrick Avenue, Suite 451, Westbury, NY 11590 ("Spark") (individually a "Party" and collectively the "Parties").

WHEREAS, 451M is a public relations agency which, in addition to providing, general advertising, public relations and branding services to businesses and individuals, specializes in creating and implementing customized communications, branding, marketing, and advertising campaigns to generate business leads for midsized to large companies. It owns pending US trademark application, Serial No. 86311557 for the mark 451 MARKETING, filed June 17, 2014, which seeks registration for "Advertising services, public relations and marketing services, namely, promoting and marketing the goods and services of others through all public communication means; Development of marketing strategies, concepts and tactics, namely, audience development, brand awareness, online community building and digital word of mouth communications; Brand creation and strategy, namely, brand concept and brand development services for corporate and individual clients." ("451M Mark"). 451M has been using its Mark since 2005. Its website at www.451marketing.com provides further detail about its services.

WHEREAS, Spark is a marketing and communications company which creates and provides direct response marketing campaigns, creates product packaging design, website design, banner design, sales collateral design and other similar graphic design and production services to implement branding campaigns created by third party companies, and which designs, develops and hosts customized software platforms to facilitate marketing automation functions. It owns US Registration No. 4465019 for the mark SPARK451®, which registered January 14, 2014, for "advertising and marketing services provided by means of indirect methods of marketing communications, namely, social media, search engine marketing, inquiry marketing, Internet marketing, mobile marketing, blogging and other forms of passive, shareable or viral communications channels to assist institutions of higher education in brand management and enrollment management." ("Spark Mark"). Spark has been using its Mark since 2011. Its website at www.spark451.com provides greater detail about these services.

WHEREAS, the USPTO cited the Spark Registration No. 4465019 against 451M Application Serial No 86311557 alleging likelihood of confusion under Section 2(d) of the Trademark Act.

WHEREAS, 451M has filed a Petition to Cancel at the US Trademark Trial and Appeal Board seeking cancellation of the Spark Registration No. 4465019 on grounds of prior use and likelihood of confusion, Cancellation No. 92061144 ("Cancellation Proceeding").

WHEREAS, the primary element of 451M's mark is the number "451".

WHEREAS, the primary element of Spark's mark is the unitary mark "Spark451".

WHEREAS, the Parties are aware of no actual confusion that has occurred between their respective Marks herein and believe that continued use of their respective Marks in adherence to the terms of this Agreement will avoid any likely confusion between them.

WHEREAS, the Parties desire to settle the Cancellation Proceeding, avoid any potential confusion with respect to the use and registration of their respective Marks, desire to assist each other in protecting, registering and avoiding any likelihood of confusion as to their respective Marks, and, therefore, desire to enter into this Agreement which they believe will accomplish these intentions.

ACCORDINGLY, in reliance upon and in exchange for the mutual covenants and conditions set forth herein and further valuable consideration, the sufficiency of which is hereby acknowledged, 451M and Spark agree as follows:

1. The Spark Mark is used in connection with the services as described above, as set forth in Registration No. 4465019, and as described on its web site at www.spark451.com. Spark does not use, does not intend to use, and agrees not to use any other mark containing both "451" and the word "MARKETING," or any mark beginning with or solely comprised of "451" for any services or goods connected in any way with the advertising, marketing, public relations, or branding industries or with the services identified in 451M's application for registration.
2. The 451M Mark is used in connection with the services as described above, in its

Application Serial No. 86311557, and as described on its web site at www.451marketing.com. 451M does not use, does not intend to use, and agrees not to use any mark consisting solely of or ending with “451” or containing the word SPARK for any services or goods connected in any way with the advertising, marketing, public relations, or branding industries or with the services identified in Spark’s Registration No. 4465019.


3. The restrictions in paragraphs 1 and 2 above are not intended to limit either Party’s use of “451,” or the words “spark” or “marketing” in a non-trademark manner and in the ordinary course of business; as a noun, verb, and/or adjective in general text..
4. The Parties agree that that they are not aware of any actual confusion that has occurred between their respective Marks during the more than four years of concurrent use. This is not to be construed as an admission by either Party that other marks owned by third parties not a Party to this Agreement which contain the number “451” would not create a likelihood of customer confusion with either Party’s respective Marks..
5. Each Party acknowledges the validity of the other Party’s Mark and each Party agrees not to oppose, challenge, object to, or take any action at law or in equity against the other Party’s use of its Mark as described herein, or against any applications for such Mark, or against any registrations that issue for such Mark, or any other marks, consistent with the terms of this Agreement, as long as such Marks are used in a manner consistent with the terms of this Agreement.
6. Each Party agrees, to the extent necessary, to provide written consent to the registration of the other Party’s Marks with the USPTO and in all other jurisdictions worldwide for services consistent with the terms of this Agreement.
7. The Parties agree to take all reasonable steps necessary to avoid confusion as to the source or origin of their respective services as described herein, as well as

any sponsorship or affiliation between them. The Parties agree to cooperate and consult with one another in good faith should future conditions or developments suggest the possibility that the Parties' Marks as noted above might be confused with one another.

8. Within seven (7) days after the Effective Date of this Agreement, 451M shall cause the pending Cancellation Proceeding to be suspended pending the withdrawal by the USPTO of the refusal under Trademark Act Section 2(d) to register the 451M Mark in Application Serial No. 86311557 in view of the Spark Mark. Within seven (7) days after withdrawal by the USPTO of the refusal under Trademark Act Section 2(d) with respect to the Spark Mark, 451M shall withdraw, with prejudice, the pending Cancellation Proceeding.
9. This Agreement shall be binding on and adhere to the benefit of the Parties and their related companies, including, but not limited to, their parent companies, subsidiaries, divisions, licensees, successors-in-interest, and assigns.
10. The Parties will bear their own costs and fees in relation to this matter.
11. This Agreement may be executed in multiple copies, and each copy shall be considered an original for all purposes.
12. The Effective Date of this agreement shall be the last date on which either party signs the Agreement.

Signed and agreed to by the Parties as follows:

451 Marketing LLC


By: 

Name: Nicholas E. Lane

Title: Founding Partner

Date: September 21, 2015

Spark451 Inc.

By: 

Name: RONALD A. TADROSS

Title: Chief Financial Officer

Date: September 22, 2015